

Cheryl

Paper No. 18

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte KENJI TAKAHASHI

MAR 14 1997

Appeal No. 95-3162
Application 07/915,200¹

PATENT OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: FEBRUARY 19, 1997

Before THOMAS, JOHN D. SMITH, and McQUADE, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The ornamental design for an OPTICAL DISC CARTRIDGE as shown and described.

¹ Application for patent filed July 20, 1992.

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The examiner has relied on the following references:

Kato et al. (Kato)	Des. 307,893	May 15, 1990
Miyazawa	Des. 311,181	Oct. 9, 1990

The design claim stands rejected under 35 U.S.C. § 103.
As evidence of obviousness, the examiner relies upon Miyazawa
in view of Kato.

We refer to the Briefs and the Answer for the respective
positions of the appellant and the examiner.

OPINION

Having carefully considered the obviousness issue raised in
this appeal in light of the teachings of the applied prior art
and in light of the examiner's remarks and the appellant's
arguments, it is our conclusion that the examiner's rejection
of the present design claim must be reversed.

"In determining the patentability of a design, it is the
overall appearance, the visual effect as a whole of the design,
which must be taken into consideration." See In re Rosen,
673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the
inquiry is to be made under 35 U.S.C. § 103, the proper standard
is whether the design would have been obvious to a designer of
ordinary skill who designs articles of the type involved. See

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In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there must be a reference, a "something in existence", the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent references, when such references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, 673 F.2d at 391, 213 USPQ at 350; In re Glavas, 230 USPQ 447, 450, 109 USPQ 50, 52 (CCPA 1956); In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). If, however, the combined teachings of the applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987).

To simplify our consideration of the issues presented in this appeal, we assume for the sake of argument that Miyazawa is, as alleged by the examiner, a proper Rosen-type reference and

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that it is properly combinable within 35 U.S.C. § 103 with the teachings and showings in Kato.

We reverse this rejection for several reasons. Initially, we note that the arrow in the front view of the claimed invention shown in Figure 3 is of relative modest size and located in the lower left portion of this showing. On the other hand, the showing of an arrow in Figure 1 of Miyazawa indicates that it is not only of significantly larger size, it is also in a different location and orientation as distinguished from that of Figure 3 of the claimed invention. The overall visual context of the front of the claimed invention in Figure 3 is dominated by the large rectangular label area and the shutter in a vertical top orientation but the side orientation of the relatively small arrow in the lower left corner is not shown among the references relied upon. This side orientation of the front arrow and its location is distinctive in context with the claimed invention depicted in back side Figure 5.

Notwithstanding these considerations, we do agree with the examiner that it would have been obvious in light of the front Figure 2 showing of Kato to have enclosed the front label area at the bottom of the top plan Figure 1 showing of Miyazawa.

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There are a number of distinctive features in the Figure 5 showing not taught or suggested, in our view, by the references relied upon. The claimed ribbed portion presents a darkened rather dominant feature in the rear Figure 5 showing of the claimed invention. There, it is located on the left edge of the claimed design in contrast to the bottom location of front Figure 2 and back Figure 3 of Kato as relied upon by the examiner. We see no reason within 35 U.S.C. § 103 for the artisan to have generically relocated the bottom front or back ribbed portion showing in Figures 2 and 3 of Kato to the side location in claimed Figure 5.

The rather lengthly shutter in claimed Figure 5 with its bottom semicircular rounded end portion goes well beyond a mere variation of a small degree by rounding of corners shown in Miyazawa or Kato's Figures, whose shutters present significantly rectangular shapes with minor or small arcuate corners. It is this rather long shutter portion of the back region, Figure 5, of the claimed invention in contrast to the front rather short, small arcuate corners of the front shutter in Figure 3, which presents a rather striking appearance. Although we recognize and generally agree with the principles set forth and relied upon by the examiner from In re Peet, 211 F.2d 602, 603, 101 USPQ 203,

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204 (CCPA 1954), that ordinarily rounding of corners is an obvious expedient to the ordinary designer, we consider that the semicircular showing of the entire bottom of the lengthy shutter in the back Figure 5 portion of the claimed invention is significantly more than a variation by a matter of degree.

Finally, and also contributing to the significance of the overall ornamental features of the claimed design, the back Figure 5 portion of the claimed invention shows an essentially T-shaped top portion of the shutter, which feature is unexplained by the examiner and the showings relied upon by the examiner in Miyazawa and Kato. Both references do not have any extensions at the top of their shutters as shown in the top rear portion of the claimed invention in Figure 5. We also disagree with the examiner's broad assertion that the configuration and location of the holes or indentations are minor variations. The art neither teaches nor suggests nor shows to the artisan the grouping of four circles or indentations in the lower left bottom of Figure 5 of the claimed invention, the rather long oblong indentation at the lower middle right side of Figure 5 of the claimed invention and the three grouped indentations on circles at the top right of Figure 5 of the claimed invention.

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In view of the foregoing, and when collectively considered, the teachings, showings and suggestions of the applied prior art would not have indicated to the artisan designer the obviousness of the claimed invention as a whole. All of the noted features, collectively taken in context, present a distinctive ornamental appearance. Therefore, the decision of the examiner rejecting the design claim on appeal within 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

John D. Smith
JOHN D. SMITH
Administrative Patent Judge

John P. McQuade
JOHN P. McQUADE
Administrative Patent Judge

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Jay H. Maioli, Esq.
Cooper & Dunham, LLP
1185 Avenue of the Americas
New York, NY 10036

JDT/cam